

25. The method of claim 10, further comprising the step of communicating to and storing at said storage device a second instruct signal effective to control a user station to receive information to supplement said television programming.

26. The method of claim 10, further comprising the step of communicating to and storing at said storage device a second instruct signal effective to process a digital television signal.

27. The method of claim 10, further comprising the step of communicating to and storing at said storage device one of a code and a datum to serve as a basis for one of enabling an output device to display at least a portion of said television programming, and for enabling a processor to process code. --

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II. REMARKS

A. Introduction

The Office Action dated February 12, 1997 (Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 2-15 are amended. Claims 2-15 are pending in the application.

Claims 2-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 2 stands rejected under 35 U.S.C. 102(e) as being anticipated by Campbell et al., U.S. Pat. No. 4,536,791.

Claims 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al., in view of Hedger et al.

All pending claims 2-15 are rejected under the judicially created doctrine of non-obviousness non-statutory double patenting over the claims in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414; and copending U.S. application 08/113,329 and related U.S. applications numbered 1-327 in the Office Action, Paper No. 10 (p. 13-15) , mailed on December 11, 1996.

All remaining claims, remain active in this application. In accordance with the foregoing, the claims have been amended to improve clarity, and further, to respond to certain rejections made by the Examiner arising under 35 U.S.C. § 112. The Examiner's comments on the claims are acknowledged and appreciated. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

Regarding paragraph 2 of the Office Action, Applicants respectfully point out that the Information Disclosure Statements filed for the subject application claim priority back to the application filed November 3, 1981, and issued as U.S. Pat. No. 4,694,490 on September 15, 1987. The present application claims priority under 35 U.S.C. § 120 of the following applications:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Patent No.</u>
08/113,329	August 30, 1993	Pending
08/056,501	May 3, 1993	5,335,277
07/849,226	March 10, 1992	5,233,654
07/588,126	September 25, 1990	5,109,414
07/096,096	September 11, 1987	4,965,825

As to the paragraph numbered 3, Applicants acknowledge their duty to maintain a line of patentable demarcation between related applications. Assuming *arguendo* that substantially duplicate claims exist, the Applicants intend to make a good faith effort to alert the PTO of any instances in which the PTO treats such claims inconsistently.

As to the paragraph numbered 4, Applicants acknowledge and appreciate the Examiner's concern over the use of alternative claim language. Applicants believe that the disclosure supports every possible embodiment or permutation that can be created using said language. During the prosecution of this application, Applicants intend to ensure that the disclosure supports each possible embodiment as claimed using alternative claims.

As to paragraphs 5 through 13 of the Office Action, Applicants' views are fully discussed in Applicants' reply brief to the rejections in application number 08/113,329, hereby incorporated by reference. Applicants will not repeat portions the response which are identical in this application. Applicants will discuss those portions of the double patenting rejection that are specific to the present application *infra*.

Paragraph 10 of the Office Action states that "determination of a possible non-statutory double patenting rejection obvious-type in each of the related 327 applications over each other will be deferred until a later time." (Office Action, p. 12 at lines 6-10). Applicants submit that the Examiner and the PTO cannot defer further rejections to a later time. Every ground of rejection should be made in Examiner's first Office Action. Title 37 of the CFR states that "[o]n taking up an application for examination . . . the Examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect to both compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated." 37 CFR § 1.104(a). The MPEP states "[t]he Examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the Examiner may be limited to such matters before action is made." MPEP § 707.07, quoting 37 CFR § 1.105. Finally, "[p]iecemeal examination should be avoided as much as possible. The Examiner

ordinarily should reject each claim on all valid grounds available . . . Where a major technical rejection is proper, it should be stated with full development of reasons rather than by mere conclusion coupled with some stereotyped expression.” MPEP §707.07(g). Applicants submit that the Examiner has a duty to give each application a complete examination, that rejections be made with specificity, and that deferred rejections are not allowed. For these reasons, Applicants likewise traverse the rejection based on the “judicially created doctrine of double patenting over the claims of copending U.S. application 08/113,329 and the following [list of all Applicants’ copending applications].” Applicants submit that this rejection, even if appropriately made with specificity, should be a provisional double patenting rejection. Applicants respectfully request that this rejection be withdrawn.

As to paragraph 12, related to the multiplicity rejection in parent file 07/096,096, Applicants submit that the PTO gave a multiplicity rejection in this case and limited Applicants to twenty-five claims. Roughly one hundred claims had been originally filed. There was no substantive review of any of the other claims outside of the twenty five. Applicants were not permitted to submit additional claims although a request was made. The disclosure of Applicants address too many subject areas to be adequately covered by a small number of claims. Applicants submit that “nexus” analysis is not required by Applicants.

As to the Office Action’s (par. 14 & 15) rejection of various of the pending claims and objections to the specification under 35 U.S.C. § 112 and related sections of the CFR and MPEP, Applicants have amended the pending claims to further the Examiner’s understanding of the claimed subject matter. Applicants, where requested and where necessary, have provided citations to the specification to demonstrate enablement. Applicants submit that the claims, as amended, are distinct as well as properly described and fully enabled by the priority disclosure. Applicants will provide detailed remarks on the Examiner’s specific objections and queries *infra*.

As to the paragraph 20, Applicants acknowledge and appreciate the interviews provided by the PTO. Applicants also appreciate the detailed description of the interviews provided in the Office Action. The Office Action states that "the Group would like to have a complete grouping of applications in a manner that was submitted earlier for only a portion of the total filings." Applicants note that based on the Office Actions received thus far, the PTO does not appear to be following the groupings Applicants submitted previously. The order of examination of Applicants' applications do not seem to have any correspondence to the groupings previously submitted. Applicants, therefore, will not supply further groupings. Applicants will, however, gladly supply further groupings if requested by the PTO for the purpose of following these groupings. Mr. Groody has confirmed in a telephone conversation between Mr. Groody and Mr. Scott that no more groupings need be sent.

In the interest of maintaining a clear record, Applicants respectfully traverse the Office Action's interview summary statement that an offer was made to terminally disclaim the present application with the '81 or '87 patents. Rather, Applicants respectfully submit that their offer was to disclaim a block of copending applications against one another, provided their issue date was in close enough proximity so as not to result in unnecessarily great losses in patent term duration.

B. Response to Rejections under 35 U.S.C. §112

1. Synopsis of the Specification

Applicants shall provide a summary of the pertinent disclosure including citation to examples supporting the claimed subject matter. The present application claims priority based on the 1987 disclosure, filed on September 11, 1987, as Ser. No. 07/096,096, and issued October 23, 1990, as U.S. Pat. No. 4,965, 825.

In their 1987 continuation-in-part specification, Applicants disclose "an integrated system of programming communication" which encompasses many

inventions and deliberately includes many embodiments. Their teaching technique is to introduce the principles of their integrated system in a series of *related* examples. Each example builds upon structure and principles introduced earlier. Examining basic principles in detail in early examples, enables the specification with concreteness to expand and extend the scope of the teaching in later examples.

Starting with "**One Combined Medium**" on page 19 which focuses on the creation and delivery of a receiver specific graph in a broadcast or cablecast television program, "Wall Street Week," the specification introduces concepts of personalization of mass media and broadcast control of receiver station computing equipment. At page 28 *et seq.* it describes apparatus that include signal processors and signal decoders and introduces the concept of a signal processor *system*. At page 40 *et seq.* it teaches the composition of signal information and the organization of message streams.

Then in a series of four **examples, #1 through #4** which begin on pages 108, 143, 162, and 197 respectively, the specification demonstrates how receiver stations communicate signal processor apparatus and methods ("*SPAM*") processor code and data of the integrated system of programming communication to *some* apparatus they actuate, how decryption occurs, how metering and monitoring take place, and how actuated apparatus perform. Each example builds on concepts introduced earlier in the specification to provide a detailed teaching of its own subject matter, and a particularly important teaching occurs from pages 156 through 162 where the specification teaches the structure and operating capabilities of a *controller of a decoder*.

Building on all that precedes it, **example #5**, which begins on page 248, then relates how the integrated system processes a multichannel communications system, which conveys different types of signals, in order to monitor programming availability and enable receiver station apparatus to receive desired programming.

From pages 278 through 312, in **example #6** and especially **example #7**, which includes both digital and analog television signals and relates to the "Wall Street Week"

program (and which has further disclosure at pages 427 through 447), the specification teaches regulating reception and use of programming of the integrated system of programming communication.

At page 312 *et seq.* it relates further monitoring concepts.

From page 324 through page 390 the specification teaches a series of transmitter station and transmitter network concepts. This portion of the specification also relies on all previous disclosure in that special attention is given to intermediate transmission stations which, *as receiver stations*, respond to programming transmissions of the integrated system as well as storing, organizing, generating, and transmitting programming. At page 340 *et seq.* **example #8** teaches distribution to, storage and organization at, and retransmission from intermediate transmission stations ("*ITS*") of SPAM programming -- most specifically television spot commercials. At page 354 *et seq.* **example #9** teaches automating intermediate transmission station combined medium operations by describing how an intermediate transmission station responds to an intermediate generation set and other elements of the integrated system to generate processor code and data and transmit the code and data with SPAM programming -- spot commercial unit Q of example #8 -- all of which are subsequently shown in the specification to operate at receiver stations to deliver receiver specific programming at video monitors, speakers, printers, and transmitters (telephones which communicate to remote data collection stations). At page 374 *et seq.* **example #10** extends the transmitter and network automating concepts of examples #8 and #9 by disclosing *a plurality* of intermediate transmission stations generating processor code and data, in the fashion of example #9, and inserting different code and data into a *network originated* transmission of SPAM programming -- again the unit Q television spot commercial.

From page 390 through 516, the specification discloses further ultimate receiver station ("*URS*") automation concepts, including regulating the URS environment (page 396 *et seq.*), controlling multiple receivers and output devices to present coordinated

output (page 406 *et seq.*), receiving selected programming of the integrated system (page 419 *et seq.*), certain *integrated system computer system concepts* (page 427 *et seq.*), whose **example #7** (page 427 *et seq.*) description relies on the receiving selected programming concepts of pages 419-427. At page 447 *et seq.* the specification discloses certain data maintenance, timing control, efficiency, and other concepts involved in controlling combined media operations. At page 457 *et seq.* the specification discloses certain timing, imaging, communication, and transmission processing concepts that relate to efficient delivery of integrated system programming. At page 463 *et seq.* the specification relates to user specific audio, print, and other combined media besides receiver specific video.

With all this preparation, the specification teaches, from page 469 through page 516, the combined media presentation of **examples #9 and #10** at a plurality of ultimate receiver stations (which are responding to signals sent by different intermediate transmission stations).

At page 516 *et seq.* the specification discloses enhancing and extending functionality of the integrated system by reprogramming receiver apparatus and enabling receiver stations to process transmissions having new forms of composition.

Finally, at page 533 *et seq.* the specification discloses "**Summary Example**" (#11) which teaches a very large scale integrated data processing and communications problem and its solution(s), using *all of* the disclosed integrated system with iterative broadcasting, response, and refinement.

Because of the integrated nature of the disclosure, no part of the specification is intended to be considered *in isolation*. However, with regard to the present application, the invention is disclosed, among other places at pp. 533 to 557, and especially at page 555, lines 2-13 recited below:

Playing each commercial spot causes the combined medium information of said spot to display information of a particular commercial product such as a truck or a particular service such as a software package; to access

the prerecorded "A:PLANTING.DAT" disk file information of a farmer's crop planting plan; in a fashion well known in the art, to generate cost/benefit financial analysis of the incremental benefit of acquiring and using the displayed product or service (by comparison with the farmer's existing product or service of like kind); and to display (or otherwise output) information of said analysis (if said analysis results in a positive net present benefit).

Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter. Applicants will provide additional specification support in their detailed response to the Examiner's specific rejections provided *infra*.

2. Remarks and Argument in Response to Examiner's General Objections

Applicants have amended the pending claims in response to various of the Examiner's objections and queries. Applicants believe that all pending claims clearly define the metes and bounds of the claimed subject matter, and are supported by an adequate written description that is fully enabling. Applicants will address each paragraph of the Office Action regarding rejections and objections under 35 U.S.C. § 112 and related sections of the CFR and MPEP below.

3. Remarks and Argument in Response to Examiner's Specific Objections

Applicants respectfully submit that amended claims 2-15 of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. Credle v. Bond, 25 F.3d 1556, 30 U.S.P.Q.2d 1911 (Fed. Cir. 1994). The legal

standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 31 U.S.P.Q.2d 1754 (Fed. Cir. 1994).

Applicants have amended the pending claims to enhance clarity and respectfully submit that said claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter. Applicants will address the Examiner's particular objections and questions *infra*.

Claims 2-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The following changes have been made to the claim language to overcome this rejection.

With respect to claim 2, "broadcast or cablecast transmission," has been changed to -- a received information transmission --; and

"one of the group;" has been changed to -- at least one of the group consisting of: --.

With respect to claim 3, "said one or more control signals operate to execute said downloadable executable code," has been changed to -- said at least one control signal operates to execute said downloadable code at said at least one of said plurality of receiver stations --; and

"transmitting an information transmission comprising said downloadable code and at least one control signal to said at least one of said plurality of receiver stations," has been changed to -- and transmitting an information transmission comprising said downloadable code and at least one control signal to said at least one of said plurality of receiver stations --.

With respect to claim 4, "some identification data," has been changed to -- and identification data --.

With respect to claim 5, "or computer," has been deleted; and

"output video, audio, or text in the context of said television program," has been changed to -- outputting one of video, audio, and text from said television program --.

With respect to claim 6, "wherein said one or more control signals incorporate some of said downloadable executable code," has been changed to -- wherein said at least one control signal incorporates at least a portion of said downloadable code --.

With respect to claim 7, all instances of "transmitter stations," has been changed to -- remote intermediate transmitter stations --; and

"transmitting said one or more control signals to said transmitter before a specific time" has been changed to -- transmitting said at least one control signal and said instruct signal to said transmitter for transmission to said at least one receiver station before a specific time --.

With respect to claim 8, "transmitting said instruct signal to said remote transmitter station," has been changed to -- transmitting said instruct signal to said remote intermediate transmitter station --.

With respect to claim 9, "said one or more control signals are effective at said remote intermediate data transmitter station to control one or more of said plurality of selective transmission devices at different times," has been changed to -- said at least one control signal at said remote intermediate transmitter station controls at least one of said plurality of selective transfer devices at different times --.

With respect to claim 10, "A method of processing signals to control a television programming presentation," has been changed to -- A method of processing signals to control television programming --.

With respect to claims 11-14 and the Office Actions rejection as improper Markush claims, claims 11 has been canceled in light of new dependent claims 16-27 which incorporate all the alternative recitations of former claim 11. However, the proper test for formation of Markush groups is that "unity of invention exists where [elements] included within a Markush group (1) share a common utility and (2) share a

substantial structural feature disclosed as being essential to that utility." MPEP 803.02. In light of this standard, claim 12, (1) shares the common utility of a condition that can be evidenced, and (2) shares the feature of essential elements television signal processing equipment; claim 13, (1) shares a common utility of a datum that is embedded, and (2) shares the feature of said datum being embedded in a television signal; claim 14, (1) shares the common utility of a signal that performs a certain function, and (2) shares the feature of said signal being embedded in a television signal.

With respect to former claim 11, now new claim 21, "said product, service, or information presentation," has been changed to -- one of a product, service, and an information presentation --.

With respect to claim 12, regarding Examiner's question regarding claim 12, the "selected location is in said television signal." Examiner is correct in reciting "storing in a TV signal."

With respect to claim 14, "a switch control signal," has been changed to -- a switch control signal that controls a switch --; "a timing control signal," has been changed to -- a timing control signal that controls with respect to a time --; and "a locating control signal," has been changed to -- a locating control signal that designates a location --.

With respect to claim 15, "said information," has been changed to -- said mass medium program --;

"outputting a mass medium program that contains or explains at least one receiver specific datum," has been changed to -- outputting a mass medium program that contains at least one receiver specific datum --;

claim 15 reads, "said interactive mass medium program output apparatus having an output device," wherein the output device is contained within the interactive mass medium program output apparatus;

line 12, "said interactive mass medium output apparatus," has been changed to -- said interactive mass medium program output apparatus --; and

"generating, in said network, a message which is effective at said interactive mass medium program output apparatus to output a user specific financial analysis," has been changed to -- generating, in said network, a user specific financial analysis which is output from said interactive mass medium program output apparatus --.

Applicants' believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. 112, first and second paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

C. Response to Rejection of Claims for Absence of Novelty

1. 35 U.S.C. §102(e) Rejection over Campbell et al., U.S. Pat. No. 4,536,791.

Off 10/2/02
Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Campbell et al., U.S. Pat. No. 4,536,791.

Campbell et al. relates to addressable cable television control systems with video format data transmission. Campbell discloses an addressable cable television control system that controls a television program and data signal transmission from a central station to a plurality of remote user stations. Campbell's data signals include both control and text signals in video line format which are inserted on the vertical interval of the television signals. An intelligent converter at each remote user location uses the data signals to control access to the system on the basis of channel, tier of service, special event and program subject matter. The converter includes apparatus for interfacing with a two-way interactive data acquisition and control system.

With respect to Applicants' amended claim 2, Campbell et al. fails to teach, *inter alia*, generating a financial analysis by processing said stored subscriber datum in response to at least one of said detected and passed control signal.⁵ Nowhere does Campbell et al. teach or suggest the generation of a financial analysis by processing a subscriber datum and a control signal.

Applicants respectfully submit that the cited art does not anticipate claim 2 since the reference fails to disclose every element of the claimed invention, and Applicants respectfully request that the 35 U.S.C. §102(e) rejection of claim 2 be withdrawn.

Applicants further respectfully submit that the claims in the present application should be allowed because these methods are not disclosed, taught, suggested, or implied by the applied prior art. For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Foundation v. Genetech, Inc., 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 18 U.S.P.Q.2d 1896 (Fed. Cir. 1991). Absence from a cited reference of any element of a claim negates anticipation of that claim by the reference. Kloster Speedsteel AB v Crucible, Inc., 230 U.S.P.Q. 81 (Fed. Cir. 1986), on rehearing, 231 U.S.P.Q. 160 (Fed. Cir. 1986).

D. Response to Obviousness Rejection of Claims

Claims 3-15 are rejected under 35 U.S.C. 103(a) as being rejected by Campbell et al., in view of Hedger et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest

all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

With respect to Applicants' amended claim 3, Campbell et al. in view of Hedger et al. fails to, *inter alia*, teach or suggest all the claim recitations, e.g., receiving at an origination transmitter station downloadable code which is effective at at least one of said plurality of receiver stations to generate a user specific financial analysis; and receiving said at least one control signal which operates to execute said downloadable code. Nowhere does Campbell et al. in view of Hedger et al. teach or suggest receiving downloadable code which is effective to generate a user specific financial analysis and receiving said at least one control signal which operates to execute said downloadable code.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 3 be withdrawn.

Claims 4-6 depend upon independent claim 3. As discussed *supra*, Campbell et al. in view of Hedger et al. fails to disclose every element of claim 3, and thus, *ipso facto*, Campbell et al. in view of Hedger et al. fails to anticipate dependent claims 4-6, and therefore, these rejections should be withdrawn and the claims be permitted to issue.

With respect to Applicants' amended claim 7, Campbell et al. in view of Hedger et al. fails to, *inter alia*, teach or suggest all the claim recitations, e.g., receiving said instruct signal to be transmitted by said remote intermediate data transmitter station and delivering said instruct signal to said transmitter, said instruct signal being effective at said receiver station to generate a user specific financial analysis. Nowhere does Campbell et al. in view of Hedger et al. teach or suggest the instruct signal being effective to generate a user specific financial analysis.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 7 be withdrawn.

Claims 8 & 9 depend upon independent claim 7. As discussed *supra*, Campbell et al. in view of Hedger et al. fails to disclose every element of claim 7 and thus, *ipso facto*, Campbell et al. in view of Hedger et al. fails to anticipate dependent claims 8 & 9, and therefore, these rejections should be withdrawn and the claims be permitted to issue.

With respect to Applicants' amended claim 10, Campbell et al. in view of Hedger et al. fails to, *inter alia*, teach or suggest all the claim recitations, e.g., receiving a first instruct signal effective to instruct a processor to generate a user specific financial analysis. Nowhere does Campbell et al. in view of Hedger et al. teach or suggest receiving an instruct signal effective to generate a user specific financial analysis.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 10 be withdrawn.

Claims 11-14 depend upon independent claim 10. As discussed *supra*, Campbell et al. in view of Hedger et al. fails to disclose every element of claim 10, and thus, *ipso facto*, Campbell et al. in view of Hedger et al. fails to anticipate dependent claims 11-14, and therefore, these rejections should be withdrawn and the claims be permitted to issue.

With respect to Applicants' amended claim 15, Campbell et al. in view of Hedger et al. fails to, *inter alia*, teach or suggest all the claim recitations, e.g., prompting said subscriber, receiving a reply from said subscriber, communicating said reply to a remote station, and generating, in a network, a user specific financial analysis which is output from said interactive mass medium program output apparatus. Nowhere does Campbell et al. in view of Hedger et al. teach or suggest prompting said subscriber, receiving a reply from said subscriber, communicating said reply to a remote station, and generating, in a network a user specific financial analysis which is output from said interactive mass medium program output apparatus.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 15 be withdrawn.

**E. Response To Rejection Based On MPEP Section 804
(II)(B)(2)**

1. Introduction

As to the Office Action's rejection of Applicants' claim under a non-statutory non-obvious type of double patenting, Applicants strongly traverse the Examiner's double patenting rejection on three separate grounds which are set forth in the reply brief for Serial No. 08/113,329 (Atty. Docket No. 05634.008), incorporated herein by reference. For the sake of brevity, these arguments will not be set forth herein; the Examiner is respectfully directed to the above-mentioned reply brief.

As an initial matter, the Examiner's rejection of the present application under the Schneller double patenting theory based on Harvey U.S. Patents 4,694,490 and 4,704,725 is improper because the present application does not claim the benefit of those applications under 35 U.S.C. §120. Thus, there could never have been a basis for claiming the present subject matter in those applications. Therefore, the rejection based on Harvey U.S. Patents 4,694,490 and 4,704,725 should be withdrawn.

Moreover, the PTO fails to specifically identify all claims from cited Harvey patents that cover specific claims in the present application. Rather, the Office Action references "representative claims" from patents and the present application. The Office Action does not cite specific elements from claims in a patent covering specific elements in claims in the application. In fact, the Office Action acknowledges that the patent claims and application claims are directed to different elements, but states that this "does not prohibit this rejection if there is common or interrelated subject matter recited." The Office Action then references Schneller in support of this erroneous statement, not supported by Schneller.

The claims in the present application are distinct from the claims in the Harvey patents. As previously mentioned, the Office Action states that the independent and distinct standard was the main factor in the Schneller court's determination that the double patenting rejection should be affirmed. The Office Action has misinterpreted this phrase. This phrase means independent 'or' distinct. MPEP (6th ed.) §802.01. The MPEP defines independent as meaning "that there is no disclosed relationship between the two or more subjects disclosed" and that they are not connected. The MPEP defines the term distinct as meaning that "two or more subjects disclosed are related . . . but are capable of separate manufacture, use, or sale as claimed" Two or more subjects cannot then be unrelated, independent, and also related, and thus distinct. Analyzing the PTO's cited representative claims referenced in the Office Action, the claims of the present application are clearly distinct from the claims in the patents and therefore the claims in the present application are patentable. Although not required, Applicants will analyze the claims of the present application with respect to the designated representative claims of Harvey U.S. Patents 4,694,490 and 4,704,725.

2. Claim 3 of the present application is distinct from the first representative claim, claim 7 of U.S. Patent 4,694,490.

Patent 4,694,490, claim 7 claims a method of communicating television program material, said material including a video signal containing a television program and an instruct-to-overlay signal, to multiple receiver stations. The video signal is received and the instruct-to-overlay signal detected and processed by a computer. The computer generates and transmits its overlay video signals to a television receiver which presents a combined display of the television program and overlay video signals, said display being specific to a particular user.

Present application claim 3, as amended, relates to a method of controlling a plurality of receiver stations comprising the steps of: receiving at an origination

transmitter station downloadable code effective at a receiver station to generate a user specific financial analysis; transferring said downloadable code to an origination station transmitter; receiving a control signal which operates to execute said downloadable code at said receiver station; and transferring said control signal from said origination transmitter station to said origination station transmitter, and transmitting an information transmission comprising said downloadable code and said control signal to said receiver stations.

Patent claim 7 does not cover present application claim 3. Patent claim 7 relates to instruct-to-overlay signals that are processed by a computer and received by a television receiver which presents a combined display of the instruct-to-overlay signal and a television program. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 4,694,490, claim 7	Present application, claim 3 (as amended)
<p>In a method of communicating television program material to a multiplicity of receiver stations each of which includes a television receiver and computer, the computers being adapted to generate and transmit overlay video signals, to their associated television receivers, said overlay signals causing the display of user specific information related to said program material, and with at least some of said computers being programmed to process overlay modification control signals so as to modify the overlay video signals transmitted to their associated receivers, each of said computers being programmed to accommodate a specific user application, and wherein a video signal containing a television program signal and an instruct to-overlay signal are transmitted to said receiver stations, the steps of:</p>	<p>A method of controlling a plurality of receiver stations, each of said plurality of receiver stations includes a television receiver, a signal detector, a processor, wherein each said receiver station is adapted to detect the presence of at least one control signal and programmed to process downloadable code, said method of controlling comprising the steps of:</p> <p>receiving at an origination transmitter station downloadable code effective at at least one of said plurality of receiver stations to generate a user specific financial analysis, said downloadable code having at each of said plurality of receiver stations a target processor to process data;</p> <p>transferring said downloadable code from said origination transmitter station to an origination station transmitter;</p> <p>receiving said at least one control signal at said origination transmitter</p>

receiving said video signal at a plurality of receiver stations and displaying said program material on the video receivers of selected ones of said plurality of receiver stations

detecting the presence of said instruct-to-overlay signal at said selected receiver stations at a time when the corresponding overlay is not being displayed, and coupling said instruct-to-overlay signal to the computers at said selected receiver stations, and

causing the computers at said selected receiver stations to generate and transmit their overlay video signals to their associated television receivers in response to said instruct-to-overlay signal, thereby to present a combined display at the selected receiver stations consisting of the television program and the related computer generated overlay, the overlays displayed at a multiplicity of said receiver stations being different, with each display specific to a specific user.

station, said at least one control signal operates to execute said downloadable code at said at least one of said plurality of receiver stations; and

transferring said at least one control signal from said origination transmitter station to said origination station transmitter, and transmitting an information transmission comprising said downloadable code and at least one control signal to said at least one of said plurality of receiver stations.

3. Claim 3 of the present application is distinct from the second representative claim, claim 3 of U.S. Patent 4,704,725.

Patent 4,704,725, claim 3 claims a method of communicating output signals comprising data and user specific signals at a multiplicity of receiver stations from computers to output devices. At least some of the computers can modify the user specific signals by processing modification control signals. The computers communicate the data and user specific signals in response to a received and detected instruct-to-transmit signal.

Present application claim 3, as amended, relates to a method of controlling a plurality of receiver stations comprising the steps of: receiving at an origination transmitter station downloadable code effective at a receiver station to generate a user specific financial analysis; transferring said downloadable code to an origination station

transmitter; receiving a control signal which operates to execute said downloadable code at said receiver station; and transferring said control signal from said origination transmitter station to said origination station transmitter, and transmitting an information transmission comprising said downloadable code and said control signal to said receiver stations.

Patent claim 3 does not cover present application claim 3. Patent claim 3 relates to the communication of user specific signals. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 4,704,725, claim 3	Present application, claim 3 (as amended)
<p>A method of communicating data to a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific signals to one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify the user specific signals transmitted to their associated output devices, each of said computers being programmed to accommodate a special user application, comprising the steps of:</p> <p>transmitting an instruct-to-transmit signal to said computers at a time when the corresponding user specific information is not being transmitted to an output device;</p> <p>detecting the presence of said instruct-to-transmit signal at selected receiver stations and coupling said instruct-to-transmit signal to the computers associated with said selected stations, and</p> <p>causing said last named computers to generate and transmit their user specific signals to their associated output devices in response to said instruct-to-transmit signal, thereby to transmit to the selected</p>	<p>A method of controlling a plurality of receiver stations, each of said plurality of receiver stations includes a television receiver, a signal detector, a processor, wherein each said receiver station is adapted to detect the presence of at least one control signal and programmed to process downloadable code, said method of controlling comprising the steps of:</p> <p>receiving at an origination transmitter station downloadable code effective at at least one of said plurality of receiver stations to generate a user specific financial analysis, said downloadable code having at each of said plurality of receiver stations a target processor to process data;</p> <p>transferring said downloadable code from said origination transmitter station to an origination station transmitter;</p> <p>receiving said at least one control signal at said origination transmitter station, said at least one control signal operates to execute said downloadable code at said at least one of said plurality of receiver stations; and</p> <p>transferring said at least one control signal from said origination transmitter station to said origination station</p>

output devices an output signal comprising said data and said related user specific signals, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.

transmitter, and transmitting an information transmission comprising said downloadable code and at least one control signal to said at least one of said plurality of receiver stations.

4. Claim 3 of the present application is distinct from the third representative claim, claim 24 of U.S. Patent 4,965,825.

Patent 4,965,825, claim 24 claims a method of generating user specific output information at a multiplicity of receiver stations. Each receiver station is programmed with a special user application and has a computer adapted to generate user specific output information. Each receiver station has an output device to which its computer transmits a user specific signal. At a time when the user specific output information does not exist, an instruct-to-generate signal is transmitted to the receiver stations. In response to the instruct-to-generate signal, the computers generate and transmit to the output devices the user specific output information in user specific signals which are different, "with each output signal specific to a specific user".

Present application claim 3, as amended, relates to a method of controlling a plurality of receiver stations comprising the steps of: receiving at an origination transmitter station downloadable code effective at a receiver station to generate a user specific financial analysis; transferring said downloadable code to an origination station transmitter; receiving a control signal which operates to execute said downloadable code at said receiver station; and transferring said control signal from said origination transmitter station to said origination station transmitter, and transmitting an information transmission comprising said downloadable code and said control signal to said receiver stations.

Patent claim 24 does not cover present application claim 3. Claim 24 relates to user specific signals sent from the receiver station to an output device. The two claims

are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 4,965,825, claim 24	Present application, claim 3 (as amended)
<p>In a method of generating computer output at a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific output information content and user specific signals to one or more associated output devices, with at least one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify said computers' method of processing data and generating output information content, each of said computers, being programmed to accommodate a special user application, the steps of:</p> <p>transmitting an instruct-to-generate signal to said computers at a time when corresponding user specific output information content does not exist, and</p> <p>causing said last named computers to generate their user specific output information content in response to said instruct-to-generate signal, thereby to transmit to each of their associated output devices an output information content and the user specific signal of its associated computer, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.</p>	<p>A method of controlling a plurality of receiver stations, each of said plurality of receiver stations includes a television receiver, a signal detector, a processor, wherein each said receiver station is adapted to detect the presence of at least one control signal and programmed to process downloadable code, said method of controlling comprising the steps of:</p> <p>receiving at an origination transmitter station downloadable code effective at at least one of said plurality of receiver stations to generate a user specific financial analysis, said downloadable code having at each of said plurality of receiver stations a target processor to process data;</p> <p>transferring said downloadable code from said origination transmitter station to an origination station transmitter;</p> <p>receiving said at least one control signal at said origination transmitter station, said at least one control signal operates to execute said downloadable code at said at least one of said plurality of receiver stations; and</p> <p>transferring said at least one control signal from said origination transmitter station to said origination station transmitter, and transmitting an information transmission comprising said downloadable code and at least one control signal to said at least one of said plurality of receiver stations.</p>

5. Claim 3 of the present application is distinct from the fourth representative claim, claim 15 of U.S. Patent 5,109,414

Patent 5,109,414, claim 15 claims a signal processing system which receives data from a data source and outputs the data to a matrix switch and a detector, control signals are detected within the received data and stored for further processing, and a processor controls the directing functions of (1) the matrix switch which receives the data as input and can direct selected portions of the data to a data transmission means and (2) the device which stores and transfers the control signals to the processor.

Present application claim 3, as amended, relates to a method of controlling a plurality of receiver stations comprising the steps of: receiving at an origination transmitter station downloadable code effective at a receiver station to generate a user specific financial analysis; transferring said downloadable code to an origination station transmitter; receiving a control signal which operates to execute said downloadable code at said receiver station; and transferring said control signal from said origination transmitter station to said origination station transmitter, and transmitting an information transmission comprising said downloadable code and said control signal to said receiver stations.

Patent claim 15 does not cover present application claim 3. Patent claim 15 relates to a data system that receives and processes data from a data source and includes a processor that controls the functions of a matrix switch and a storage device. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 5,109,414, claim 15	Present application, claim 3 (as amended)
In a signal processing system, a receiver/distribution means for receiving data from a data source and for outputting said data to a matrix switch means and a control signal detector means,	A method of controlling a plurality of receiver stations, each of said plurality of receiver stations includes a television receiver, a signal detector, a processor, wherein each said receiver station is

a matrix switch means for receiving said data from said receiver/distributor means and for directing selected portions of said received data to a data transmission means,

a control signal detector means for detecting control signals respecting said data and transferring said control signals to a storage/transfer means, said control signal means being configured to detect said control signals at a predetermined location within said data,

a storage/transfer means for receiving and storing said control signals and for transferring at least a portion of said control signals to a processor means for further processing, and

a processor means for controlling the directing functions of said matrix switch means and the transfer functions of said storage/transfer means based on instructions contained in said control signals.

adapted to detect the presence of at least one control signal and programmed to process downloadable code, said method of controlling comprising the steps of:

receiving at an origination transmitter station downloadable code effective at at least one of said plurality of receiver stations to generate a user specific financial analysis, said downloadable code having at each of said plurality of receiver stations a target processor to process data;

transferring said downloadable code from said origination transmitter station to an origination station transmitter;

receiving said at least one control signal at said origination transmitter station, said at least one control signal operates to execute said downloadable code at said at least one of said plurality of receiver stations; and

transferring said at least one control signal from said origination transmitter station to said origination station transmitter, and transmitting an information transmission comprising said downloadable code and at least one control signal to said at least one of said plurality of receiver stations.

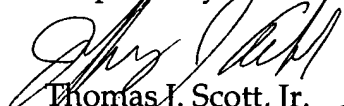
III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections are rejections have been overcome and/or rendered moot. Further, that all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

Date: August 12, 1997
HOWREY & SIMON
1299 Pennsylvania Avenue, NW
Washington, D.C. 20004
Tel: (202) 383-6614

Respectfully submitted,

 ny # 32 680
for
Thomas J. Scott, Jr.
Reg. No. 27,836
Attorney for Applicants